

II. REMARKS

Claims 1 to 40 and 56 to 64 will be pending.

It is alleged in the Communication that the claims are directed to three independent and patentably distinct inventions, which have been set forth as follows:

Group I: claims 1 to 10, 13 to 19, 21 to 32, and 34 to 40, directed to a method of forming a nucleic acid;

Group II: claims 11 and 12, directed to a cell; and

Group III: claims 20, 33 and 56 to 64, directed to a composition and kit.

Applicants respectfully traverse the restriction requirement for the reasons set forth below. Nevertheless, in order to be fully responsive to the Communication, the claims of Group I, claims 1 to 10, 13 to 19, 21 to 32, and 34 to 40 are provisionally elected for examination.

The Restriction Requirement is traversed because it clearly would not constitute an undue burden for the Examiner to examine all of the claims together. In fact, the claims previously were examined together by a previous Examiner, and art relevant to the claims of all three Groups was identified (see Office Action mailed June 4, 2003; e.g., claims 1 to 51 and 53 to 64 rejected under 35 U.S.C. 103(e) as allegedly anticipated by Heyman et al.). Thus, it is clear from the previous Office Action that a search of all of the claims did not constitute an undue burden and revealed art relevant to claims in each of the Groups as set forth in the present Communication. As such, it is requested that the Restriction Requirement be removed for this reason.

The Restriction Requirement also is traversed because, pursuant to the substantive Office Action mailed June 4, 2003, Applicants cancelled claims 41 to 55. As such, claims 41 to 55 are not subject to the Restriction Requirement and, therefore, not subject to the protection provided under 35 U.S.C. § 121, which states:

35 U.S.C. 121 Divisional applications.

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of Section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

(Amended Jan. 2, 1975, Public Law 93-596, sec. 1, 88 Stat. 1949; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).); emphasis added.

Because claims 41 to 55 were cancelled, and are not subject to the Restriction Requirement, Applicants were not afforded an opportunity to obtain the benefit provided by Section 121 of the

Code. As such, a Restriction Requirement at this stage of the prosecution could severely prejudice the Applicants. For example, had original claims 41 to 55 been subject to restriction, and cancelled pursuant to a Restriction Requirement, they would have obtained the benefit of protection under Section 121 of the Code. As such, it is respectfully requested that the Restriction Requirement also be withdrawn for this reason.

Finally, the Restriction Requirement is traversed by there is no indication that the previous Examiner made a clear error in not restricting the pending claims. As discussed above, the previous Examiner searched all of the claims and found art relevant to claims in each of the Groups set forth in the present Restriction Requirement. In this respect, it is noted that Section 706.04 of the MPEP indicates:

PREVIOUS ACTION BY DIFFERENT EXAMINER

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).

Although Applicants recognize that the above statement is made with respect to an indication by a previous Examiner that claims are allowed, it is submitted that the standard is relevant to any stage of prosecution because, absent such a standard, an Applicant cannot be assured of consistent examination. In this respect, it is noted that, in the present case, such inconsistent examination can prejudice the Applicants because, as discussed above, claims were cancelled pursuant to Applicants' response to the substantive Office Action mailed June 4, 2003. As such, it is requested that the Restriction Requirement also be withdrawn for this reason.

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In summary, Applicants submit that, as evidenced by the Search that revealed art relevant to all of the claims (see Office Action mailed June 4, 2003), it would not constitute an undue burden for the present Examiner to examine all of the claims together; and further, that a Restriction Requirement at the present stage of prosecution would unduly prejudice the Applicants. Accordingly, it is respectfully requested that the Restriction Requirement be withdrawn, and that claims 11, 12, 20, 33 and 56 to 64 be examined with provisionally elected claims 1 to 10, 13 to 19, 21 to 32, and 34 to 40.

For the reasons set forth in Applicants' Amendment mailed October 23, 2003, it is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to the subject application.

Enclosed is Check No. 555918 in the amount of \$110.00 in payment of the One (1) Month extension of time fee. The Commissioner is hereby authorized to charge any other fees that may be associated with this communication, or credit any overpayment, to Deposit Account No. 50-1355.

Respectfully submitted,

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